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10/619,516

07/14/2003

Shinichi Takada

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03/29/2005

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EXAMINER

DI GRAZIO, JEANNE A

ART UNIT

PAPER NUMBER

2871

DATE MAILED: 03/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/619,516

Applicant(s)

TAKADA ET AL.

Examiner

Jeanne A. Di Grazio

Art Unit

2871

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on Election 12/01/04.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
4a) Of the above claim(s) 6 and 11 is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-5 and 7-10 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 14 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 14 July 2003.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Priority

Priority to Japanese Patent Application 2002-223356 (July 31, 2002) is claimed.

Receipt is acknowledged of papers (certified Japanese language document) submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Preliminary Amendment

Applicant's Preliminary Amendment of July 14, 2003 is noted and acknowledged.

Election/Restrictions

Applicant's election without traverse of Group I drawn to a surface protective film for transparent conductive films (claims 1-5 and 7-10 readable thereon) in the reply filed on December 1, 2004 is acknowledged.

Claims 6 and 11 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected Group II (method for manufacturing a surface protective film for transparent conductive films) there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on December 1, 2004.

Claim Objections

Claim 1 is objected to because of the following informalities:

As to claim 1, Applicant recites “protecting a surface of a side opposite to a conductive thin film or a surface on a side of a conductive thin film of the transparent conductive film, wherein an adhesive layer is formed on one side of a base material film ...”

The word “side” is confusing and unclear in the context of a film. A film is defined as “a thin skin or membranous covering”, “a thin covering or coating” and “an exceedingly thin layer.” (Merriam Webster’s Collegiate Dictionary 10TH Ed. at page 435)(providing definitions of “film”)(photocopy provided to Applicant). A film may have front and back / top and bottom surfaces but does not have sides.

The Examiner further notes that a definition of “side” may include “either surface of a thin object” (Id. at page 1089)(photocopy provided to Applicant).

Thus, the Examiner, for examination purposes, takes side to mean -- surface -- .

Appropriate correction is required.

Claims 4-5 and 7-10 are objected to because of the following informalities:

As to claims 4-5 and 7-10, as noted above with respect to claim 1, the word “side” is confusing and unclear in the context of a film. A film is defined as “a thin skin or membranous covering”, “a thin covering or coating” and “an exceedingly thin layer.” (Merriam Webster’s Collegiate Dictionary 10TH Ed. at page 435)(providing definitions of “film”)(photocopy provided to Applicant). A film may have front and back / top and bottom surfaces but does not have sides.

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It is noted that Applicant appears to equate surface and side in these claims (“other surface side”). As such, this renders said claims unclear and confusing because a film cannot be said to have sides.

For examination purposes, the Examiner interprets said limitations as consistent with the current art of record.

Appropriate correction is **required**.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3 are rejected under 35 U.S.C. 102(b) as being anticipated by Japanese Patent Application No. JP11268168 (to Asaoka et al.)(published Oct. 5, 1999)(provided by Applicant).

As to claim 1, Asaoka has a plastic film laminate of a transparent conducting film formed on a surface of a plastic film and a protective film formed on the opposing surface of the plastic film (Abstract and single embodiment at page 2 of machine translation). Asaoka also has an adhesive binder (acrylic adhesive) that sticks the films together [0010]. The adhesive is on a plastic film (Applicant’s “base material film”) of polyethylene terephthalate (PET) for example [Embodiment of the Invention]. Asaoka also has a heat shrinkage of 0.5% or less or 0.3% or less [0009] in both machine direction (MD) and width direction (TD)(entire publication).

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Please note that the Examiner reads the limitation “after being heated at 150⁰C for 1 hour” as a product-by-process limitation and said limitation is not considered.

It is respectfully noted that patentability does not rest merely on the process by which a product is made. Rather, it must be the product itself that is new, useful and not obvious.

As to claim 2, please note that the Examiner reads the limitation “a treatment for removing a residual stress is performed to the base material film” as a product-by-process limitation and said limitation is not considered.

It is respectfully noted that patentability does not rest merely on the process by which a product is made. Rather, it must be the product itself that is new, useful and not obvious.

As to claim 3, the base material is a polyethylene terephthalate (PET) film as noted with regard to claim 1.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 4-5 and 7-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Japanese Patent Application No. JP11268168 (to Asaoka et al.)(published Oct. 5, 1999)(provided by Applicant).

As to claims 4-5 and 7-10, Asaoka does not appear to explicitly specify hard coat layers, anti-glare layers and specific arrangements of the films.

However, Asaoka does have an optimal arrangement of films for preventing curling caused by thermal treatment during the manufacturing process (entire publication).

Asaoka is evidence that ordinary workers in the field of surface protective films would have found the reason, suggestion and motivation to optimally arrange films to prevent curling and thus to prevent deterioration of the films.

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Therefore, it would have been obvious to one of ordinary skill in the art of surface protective films to optimally arrange films to prevent curling and thus to prevent deterioration of the films.

Please note that the limitation “simultaneously” is interpreted as a product-by-process limitation and said limitation is not considered. Simultaneously means “existing or occurring at the same time : exactly coincident.” (Merriam Webster’s Collegiate Dictionary 10TH Ed. at page 1094)(providing definitions of “simultaneously”)(photocopy provided to Applicant). The gerund “occurring” indicates a method or process as in a sequence of events.

It is respectfully noted that patentability does not rest merely on the process by which a product is made. Rather, it must be the product itself that is new, useful and not obvious.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeanne A. Di Grazio whose telephone number is (571)272-2289.


The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Kim, can be reached on (571)272-2293. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Jeanne Andrea Di Grazio
Patent Examiner
Art Unit 2871

JDG


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